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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 479

WALSTEIN C. FINDLAY, JR., FINDLAY GALLERIES, INC., and W. C. F. GALLERIES, INC.,
Petitioners,

v.

DAVID B. FINDLAY, INC., FINDLAY ASSOCIATES, INC., and DAVID B. FINDLAY,
Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE COURT OF APPEALS OF THE STATE OF NEW YORK

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TO THE CHIEF JUSTICE OF THE UNITED STATES AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Your petitioners respectfully pray that a writ of certiorari issue to review the judgment of the Court of Appeals of the State of New York, entered in the above entitled case on June 9, 1966.

Opinions Below

The opinion of the Supreme Court of the State of New York (R. 132-44) is reported at 47 Misc. 2d 649,

262 N. Y. S. 2d 1008 (Sup. Ct. N. Y. County 1965). The Appellate Division of the Supreme Court of the State of New York affirmed without opinion. (R. 150). 23 App. Div. 2d 846, c. 2, 259 N. Y. S. 2d 1010 (1st Dept. 1965). The opinions of the New York Court of Appeals (Appendix A, *infra* pp. A1-A11) are reported at 18 N. Y. 2d 12 (1966).

Jurisdiction

The judgment of the Court of Appeals of the State of New York was entered on June 9, 1966. The jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1257(3). That the federal questions raised here were presented to and passed on by the Court of Appeals of the State of New York is attested by the amended remittitur issued by that Court on July 7, 1966, and set out in Appendix B (*infra* pp. B1-B2).

Questions Presented

1. Can the courts of the State of New York confer on the respondents the exclusive right to use a family name as a trade name in interstate commerce contrary to the provisions of the Lanham Act and decisions of the federal courts?

2. Can the courts of the State of New York constitutionally deprive the petitioners of the right to use a family name as a trade name in interstate commerce absent any fraud, deceit, or misrepresentation in their use of the name or carrying on the business?

Statutes Involved

The relevant provisions of the Lanham Act §§ 2-(e)(3), 44(b) and 44(i), 60 Stat. 427 (1946), 15 U. S. C. §§ 1052(e)(3), 1126(b), and 1126(i) are as follows:

§ 1052.

No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

* * * * *

(e) Consists of a mark which, (1) when applied to the goods of the applicant is merely descriptive or deceptively misdescriptive of them, or (2) when applied to the goods of the applicant is primarily geographically descriptive or deceptively misdescriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, or (3) is primarily merely a surname.

§ 1126.

* * * * *

(b) Any person whose country of origin is a party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition, to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of a mark is otherwise entitled by this chapter.

* * * * *

(i) Citizens or residents of the United States shall have the same benefits as are granted by this section to persons described in subsection (b) of this section.

Statement

This is a suit by David B. Findlay and his corporate affiliates to prevent Walstein B. Findlay and his corporate affiliates from using the name Findlay in connection with the latter's New York art gallery. (R. 6) David and Walstein Findlay are each engaged in the sale in interstate commerce of paintings and other works of fine art. (R. 32-33; 59-60; 65; 70; 74; 77; 79) Both specialize in the sale of contemporary imported paintings by artists under exclusive contracts to them. (R. 69-70; 158; 112-13) They have operated their businesses independently of each other, each using the Findlay name, since 1938. (R. 26 ff.; 59; 66; 96 ff.) The business of each derives from that created by their grandfather in Kansas City in 1870 and maintained thereafter by their grandfather and father. (R. 22; 95) The parent concern had had galleries in New York and Chicago as well as in Kansas City. (R. 22; 95-96) Both David Findlay and Walstein Findlay claim succession from the original Findlay galleries. Both advertise that their businesses were founded in 1870, *i.e.*, when the Kansas City business was created.

In 1938, the brothers who are contestants in this case came to a parting of the ways. (R. 23) Walstein took over the Chicago galleries and pursuant to an agreement between him and David was specifically given the

right to use the name "Findlay Galleries, Inc., in the conduct of his business." (R. 15) Thereafter, the brothers prospered in their respective operations, (R. 75-76; 78; 109) each making use of the family name to engage in nationwide sales. David maintained his gallery in New York. (R. 27 ff.) Walstein maintained a gallery in Chicago, (R. 97-98) added one in Palm Beach, Florida, (R. 101-103) and then another in New York City. (R. 110) A third brother has a gallery in Chicago that also makes use of the Findlay name. (R. 114) Prior to opening his New York gallery, Walstein had utilized temporary quarters there from time to time for the exhibition and sale of paintings and each time he did so under the Findlay name. (R. 60; 99)

The New York trial court found that Walstein, in opening a New York gallery, had no intention to deceive, or intention to exploit the good will or reputation of David Findlay. (R. 135) It could hardly have concluded otherwise. The name that Walstein sought to use was the same as that under which he had been doing business for almost thirty years. (R. 96 ff.) The products that both brothers were selling were as far from being fungible or subject to confusion one with another as any objects could be. And plaintiff's customers are best described in the plaintiff's own words: "[a] very knowledgeable clientele who are interested in acquiring fine things." (R. 36) Walstein's purpose in using the Findlay name on his New York gallery was to make use of the nationwide reputation that he had himself created for his galleries. (R. 122) Nevertheless, as a result of a 4-3 decision by the New York Court

of Appeals, Walstein is now enjoined from the use of the Findlay name, *i.e.*, his own name, in connection with his New York gallery. See Appendix C (*infra* pp. C-1 – C-3).

REASONS FOR GRANTING THE WRIT

I.

The decision of the New York Court of Appeals is in conflict with the decisions of this Court and the lower federal courts which have consistently held that a defendant may not, in the absence of fraud or deceit, be deprived of the use of his name in business simply because it may cause confusion with another business using the same name.

The decisions of this Court have made it abundantly clear that a man may not be deprived of the use of his own name in carrying on his business simply because another business of the same kind is being carried on under the same or a similar name. This Court, in *Howe Scale Co.* v. *Wyckoff, Seamans etc.*, 198 U. S. 118 (1905), on the basis of ample authority, reasserted the principle from which it has never departed:

> Doubtless the Remingtons and Sholes, in using the name "Remington-Sholes," desired to avail themselves of the general family reputation attached to the two names, but that does not in itself justify the assumption that their purpose was to confuse their machines with complainant's; or that the use of the name was in itself calculated to deceive. Remington and Sholes were interested in the old company, and Remington continued as general manager of the new company. Neither of them was paid for the use of his name, and

> neither of them had parted with the right to that use. Having the right to that use, courts will not interfere where the only confusion, if any, results from a similarity of the names and not from the manner of the use. The essence of the wrong in unfair competition consists in the sale of the goods of one manufacturer or vendor, for those of another, and if defendant so conducts its business as not to palm off its goods as those of the complainant, the action fails. [198 U. S. at 139-40.]

Even where there was fraudulent intent on the part of the defendant, the most that this Court has condoned by way of a decree is that the defendant's own name be adequately distinguished from that of the plaintiff complaining of the use. See *Waterman Co.* v. *Modern Pen Co.*, 235 U. S. 88 (1914).

That this rule has been adhered to by the federal courts is evidenced by the decision of the Court of Appeals for the Sixth Circuit in *Crane Co.* v. *Crane Heating & Air Conditioning Co.*, 299 F.2d 577 (6th Cir. 1962), where the court held:

> In our opinion, the Crane brothers had the right to use their surname Crane in their business so long as they did not attempt to palm off the products which they handled as products of Crane Co. or mislead the public into believing that they were dealing with Crane Co. . . .
>
> It was, of course, proper for R. J. Crane to use his surname in the business which he established known as Crane Co. The Crane brothers have the same privilege so long as they do not attempt to deceive or mislead. [299 F.2d at 578.]

This uniform rule has been abandoned by the federal courts only when they have undertaken to follow state law rather than the controlling federal law, as in *Lane Bryant, Inc.* v. *Maternity Lane,* 173 F.2d 559 (9th Cir. 1949).

II.

There is a conflict among the circuits on the important question whether the Lanham Act has preempted the law of unfair competition among businesses engaged in interstate commerce or whether state law is controlling in this area.

It is obvious that if the foregoing federal authorities are controlling the judgment of the court below must be reversed. It must be admitted, however, that the circuits are in conflict on the question whether national law of unfair competition is controlling. The Court of Appeals for the Ninth Circuit has held that, by reason of § 44 of the Lanham Act, 15 U. S. C. § 1126, enacted in 1946, all claims of unfair competition by those engaged in interstate commerce are federal questions to be resolved by national law. See *Stauffer* v. *Exley,* 184 F.2d 962 (9th Cir. 1950); *Pagliero* v. *Wallace China Co.,* 198 F.2d 339 (9th Cir. 1952); *Ross-Whitney Corp.* v. *Smith, Kline & French Laboratories,* 207 F.2d 190 (9th Cir. 1953). See also Bunn, *The National Law of Unfair Competition,* 62 HARV. L. REV. 987 (1949). Other circuits have specifically rejected this reading of the Lanham Act and have held that state law is controlling in resolving a question of unfair competition not specifically preempted by national law even among

those engaged in interstate commerce. *Flexitized, Inc.* v. *National Flexitized Corp.*, 335 F.2d 774 (2d Cir. 1964); *Maternally Yours, Inc.* v. *Your Maternity Shop, Inc.*, 234 F.2d 538 (2d Cir. 1956); *L'Aiglon Apparel, Inc.* v. *Lana Lobell, Inc.*, 214 F.2d 649 (3d Cir. 1954); *Royal Lace Paper Works, Inc.* v. *Pest-Guard Products, Inc.*, 240 F.2d 814 (5th Cir. 1957); *Independent Nail & Pack Co.* v. *Stronghold Screw Prod.*, 205 F.2d 921 (7th Cir. 1953). Certainly this is a conflict among circuits on an important question that can and ought to be resolved by this Court through the grant of certiorari in this case.

III.

The decision below is inconsistent with the judgments of this Court in the *Compco* and *Stiffel* cases.

Even if national law has not totally preempted the field of unfair competition in interstate commerce, the decision of the New York Court of Appeals in this case is inconsistent with the law established by this Court in *Compco Corp.* v. *Day-Brite Lighting Co.*, 376 U. S. 234 (1964), and *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U. S. 225 (1964).

Section 2(e)(3) of the Lanham Act specifically denies the right of registration to a trade-mark that is essentially a surname. 15 U. S. C. § 1052(e)(3). And the federal rule set out in Part I hereof has been applied even where the plaintiff is relying on a trade-mark registered under the Lanham Act. See, *e.g.*, *John P. Dant Distillery Co.* v. *Schenley Distillers, Inc.*, 297

F.2d 935 (6th Cir. 1962); *S. C. Johnson & Son, Inc.* v. *Johnson*, 266 F.2d 129 (6th Cir. 1959). There can be no doubt that federal law is controlling in these circumstances. These cases clearly establish the principle that even a properly registered trade-mark does not afford a monopolistic use of a proper name against a person who has a natural right to such use. Yet, if the New York decision is permitted to stand, it will mean that state courts are capable of raising a non-registered—and frequently unregisterable—trade-mark to a monopoly status that national law now specifically denies it. Such a conclusion is clearly inconsistent with the national policy against registration of surnames as expressed in the Lanham Act and the decisions of this Court in *Compco* and *Stiffel*. To paraphrase the Court's language in the *Stiffel* case: "Just as a State cannot encroach upon the federal [trade-mark] laws directly, it cannot, under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objectives of the federal [trade-mark] laws." 376 U. S. at 231.

IV.

The action of the New York Court of Appeals depriving the defendant of his right to use his own name in carrying on his own business, as he has done for many years, constitutes a deprivation of liberty and property without due process of law.

Various courts throughout our history have labelled the right to do business under one's own name as a "sacred right," a "natural right," and a "constitutional right." Thus, the New Jersey court in the

famed case of *Hilton* v. *Hilton*, 89 N. J. Eq. 182, 193, 104 Atl. 375, 376 (1918), said that "the right of a man to use his own name in his own business is part of the natural and inalienable rights guaranteed by the very first clause of our Constitution, without which the right to acquire, possess and protect property would be of little worth." The reason for such treatment of this right was succinctly stated by the Court of Appeals for the Second Circuit in *Societe Vinicole de Champagne* v. *Mumm*, 143 F.2d 240 (2d Cir. 1944): "No one chooses the name which his parents give him; it is imposed on him willy-nilly; and before he has had any chance to change it, those associations which identify him have clustered about it. To prevent all use of it is to take away his identity; without it he cannot make known who he is to those who may wish to deal with him; and that is so grievous an injury that courts will avoid imposing it, if they possibly can." (p. 241)

The right to use one's own name in business may be regarded as an aspect of personality as suggested by the quotation from the *Mumm* case. Or, it may be regarded, as this Court has regarded it: "A man's name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property." *Brown Chemical Company* v. *Meyer*, 139 U. S. 540, 544 (1891). In either event, it is a right entitled to the protection afforded by the Fourteenth Amendment that should preclude its destruction by the state in the absence of a demonstration of wrongdoing by its owner.

This Court, and the courts of other states, including New York, have followed the English precedents which

have held that the right to use one's own name in business is one of the rights of Englishmen. Lord Esher, M.R., said a man "has an absolute right by the law of *England*" to carry on business in his own name, in the absence of fraud. *Turton* v. *Turton*, 42 Ch. D. 128, 136 (C. A. 1889).

Lord Justice Knight Bruce put it bluntly in *Burgess* v. *Burgess*, 22 L. J. Ch. 675, 679 (1853):

> "All the Queen's subjects have a right, if they will, to manufacture and sell pickles and sauces, and not the less that their fathers have done so before them. All the Queen's subjects have a right to sell them in their own name, and not the less so that they bear the same name as their father * * *".

This right of Englishmen is of the kind which is entitled to protection under the Ninth and Fourteenth Amendments to the Constitution. See *Griswold* v. *Connecticut*, 381 U. S. 479 (1965).

CONCLUSION

The questions presented herein are obviously both substantial and important, not the less so because of the conflict among the circuits. This petition for a writ of certiorari should, therefore, be granted.

Respectfully submitted,

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APPENDIX A

Opinions of the Court of Appeals of New York

DAVID B. FINDLAY, INC., et al., Respondents, *v.* WALSTEIN C. FINDLAY, JR., et al., Appellants.

Decided June 9, 1966.

APPEAL, by permission of the Court of Appeals, from an order of the Appellate Division of the Supreme Court in the First Judicial Department, entered May 25, 1965, which unanimously affirmed a judgment of the Supreme Court in favor of plaintiffs, entered in New York County upon a decision of the court at a Special and Trial Term (EMILO NUNEZ, *J.*; opinion 47 Misc 2d 649) (1) enjoining defendants, their officers, agents and employees, from using or employing, or causing to be used or employed, the names "Wally Findlay Galleries", "Findlay Galleries" and any other style or designation which included the name "Findlay" in or as any part of the trade or business name under which defendants or any of them might conduct an art gallery or art business on East 57th Street in the Borough of Manhattan, City of New York, (2) granting related injunctive relief in favor of plaintiffs and (3) ordering that the said injunctive provisions were to apply only so long as plaintiffs or any of them maintained an art gallery or conducted an art business at premises located on East 57th Street in the Borough of Manhattan, City of New York.

Milton Pollack and *Francis E. Koch* for appellants.

J. Kenneth Campbell and *Alexander Neave* for respondents.

KEATING, J. When should a man's right to use his own name in his business be limited? This is the question before us.

The individual plaintiff David B. Findlay ("David") and the individual defendant Walstein C. Findlay ("Wally") are brothers. The Findlay art business was founded in 1870 by their grandfather in Kansas City. Their father continued and expanded the business with a Chicago branch managed by Wally and a New York branch established and managed by David on East 57th Street. In 1936 the Kansas City gallery was closed and in 1938, after a dispute, the brothers separated. By agreement David, as president of Findlay Galleries, Inc., and owner of nearly all of the stock of the original Missouri corporation, sold to Wally individually the Chicago gallery and allowed Wally to use the name "Findlay Galleries, Inc." in the conduct of his business in Chicago. Wally organized an Illinois corporation under the name "Findlay Galleries, Inc." in 1938 and has since operated his Chicago gallery. He also opened, in 1961, a Palm Beach, Florida gallery.

David, since the separation, has operated his gallery on East 57th Street in Manhattan. For many years he has conducted his business on the second floor of 11-13 East 57th Street.

In October, 1963, Wally purchased the premises at 17 East 57th Street and informed David of his plans to open an art gallery. David objected to Wally's use of the name "Findlay" on 57th Street and by letter announced he would "resist any appropriation by you in New York of the name Findlay in connection with a

gallery * * * any funds spent by you to establish a gallery at 17 East 57th Street under the name Findlay Galleries, Inc. (or any variation thereof using the name Findlay) are spent at your peril." David also, in self-defense and in an effort to survive, rented additional space at 15 East 57th Street so as to have a street level entrance.

David's objections and pleas seemed to have some effect on Wally. As renovation on the building was carried on from October, 1963 to September, 1964, a large sign proclaimed the coming opening of "W. C. F. Galleries, Inc." There was also a display and listing in the New York Telephone directory under the same name and similar advertisements in other publications. However, in September, 1964 the sign was suddenly changed to announce the imminent opening of "Wally Findlay Galleries," affiliated with "Findlay Galleries, Inc." David immediately sought an injunction. Wally went ahead with his opening and erected a sidewalk canopy from the curb to the building displaying the name "Wally Findlay Galleries."

The trial court made very detailed findings and, based on them, enjoined defendant from using the names "Wally Findlay Galleries", "Findlay Galleries" and any other designation including the name "Findlay" in the conduct of an art gallery on East 57th Street. The Appellate Division has affirmed on the trial court's findings and we find evidence to sustain them.

The trial court concluded that if injunctive relief were not granted, plaintiff would continue to be damaged by confusion and diversion and would suffer great

and irreparable loss in his business and in his name and reputation. In his quarter of a century on East 57th Street David has established a valuable goodwill and reputation as an art dealer. Through hard work, business ability and expenditure of large sums of money, David has reached the level where a significant portion of his business comes from people who have been referred to him by others and told to go to "Findlay's on 57th St."

The effect of Wally's new gallery, with its long canopy, can only be that those looking for "Findlay's on 57th St." will be easily confused and find their way into Wally's rather than David's gallery. Though Wally perhaps did not deliberately set out to exploit David's goodwill and reputation, the trial court found, and we agree, that such a result would follow if Wally were permitted to operate a gallery under the name "Wally Findlay Galleries" next door to David.

There were numerous instances of people telephoning or asking at David's for personnel of Wally's or for art work exhibited at Wally's. Many regular customers congratulated David on the opening of "his" new gallery next door. Moreover, advertisements frequently appeared on the same pages of the local press for "Findlay Galleries", "Findlay's", or "Wally Findlay Galleries" thus making it very difficult to tell whose advertisement it was. Even the art editors and reporters referred to Wally as "Findlay Galleries"—the name used for many years by David—or as "the new Findlay Gallery."

It is apparent that confusion has and must result from Wally's opening next to David. This is com-

pounded by the fact that both brothers have for years specialized in French impressionist and post-impressionist painters. Therefore, quite naturally, both brothers have in the past dealt in the works of such famous deceased painters as Modigliani, Degas, Renoir, Gauguin, Bonnard, Braque, Monet and many others.

Although someone seeking a Renoir from David is unlikely to purchase a Degas from Wally, it *is* likely that with respect to some of the lesser-known impressionists such diversion might happen. More important, someone wishing to own a nude by Modigliani, a dancer by Degas or a portrait of a girl by Renoir would not necessarily have a particular painting in mind and would likely purchase any of these species, whether it be in Wally's or David's. The items sold by the two brothers are not unique, nonsubstitutional works.

Moreover, art, particularly modern art, is sold only to those who see it. Works of art are sold to those who cross the threshold of the art gallery and the more people you get into your gallery, the more art you will sell. To this end David has worked hard to develop the name "Findlay's on 57th Street" and bring in customers. Many people who have the finances to purchase art do not necessarily have the knowledge to distinguish between the works of all the various painters represented by galleries such as Wally's or David's. For this reason they rely on the reputation of the gallery. David has spent over 25 years in developing satisfied customers who will tell others to go to "Findlay's on 57th Street." This goodwill brings in customers who look for a work of art that suits their fancy, and if Wally were to con-

tinue to use the name Findlay, it is inevitable that some would walk into Wally's by mistake and would have their tastes satisfied there, to David's great harm.

The so-called "sacred right" theory that every man may employ his own name in his business is not unlimited. Moreover, fraud or deliberate intention to deceive or mislead the public are not necessary ingredients to a cause of action. See *Higgins Co.* v. *Higgins Soap Co.* (144 N. Y. 462, 468).

The present trend of the law is to enjoin the use of a family name when such use tends or threatens to produce confusion in the public mind (*Sullivan* v. *Sullivan Radio & T. V.*, 1 A D 2d 609). Whether this confusion should be satisfied by misplaced phone calls or confusing advertisements alone we do not decide because there has been a finding that diversion, as well as confusion, will exist if Wally is not enjoined. Thus it is clear that the "confusion" with which we are dealing includes impairment of goodwill of a business.

In *Meneely* v. *Meneely* (62 N. Y. 427) this court noted that one can use his own name provided he does not resort to any artifice or contrivance for the purpose of producing the impression that the establishments are identical, or do any thing calculated to mislead the public.

35 years later, we noted that as a general principle of law, one's name is his property and he is entitled to its use. However, it was equally a principle of law that no man can sell his goods as those of another. "He may not through unfairness, artifice, misrepre-

sentation or fraud injure the business of another or induce the public to believe his product is the product of that other." (*World's Dispensary Med. Assn.* v. *Pierce,* 203 N. Y. 419, 424.)

Ryan & Son v. *Lancaster Homes* (15 N Y 2d 812 affg. 22 A D 2d 186) is distinguishable from the present case because there was lacking in *Ryan* the crucial finding that in the absence of relief plaintiff would be damaged by confusion and diversion. There was no real competition between the two businesses. Again, unlike the instant case where "Findlay's on 57th St." is synonymous in New York City with quality art galleries, "Homes by Ryan" had not become a trade name with a secondary meaning. The court reviewed the law and cited the rule in *Meneely.* "This rule has been qualified, as we have said, only to the extent that use of a family name will be restricted where such use tends or threatens to induce confusion in the public mind". (22 A D 2d 190.)

In the present case Wally knew that David had conducted his business and built a reputation under the names "Findlay Galleries" and "Findlay's on 57th St." and that many years of effort and expenses had gone into promoting the name of "Findlay" in the art business on 57th Street. He also knew that people would come into his gallery looking for "Findlay Galleries" and even instructed his employees on this matter before he opened. Nonetheless he opened his gallery next door to David dealing in substantially similar works and using the name Findlay. The bona fides of Wally's intentions do not change the applicable principles. The objective facts of this unfair competition and injury to plaintiff's business are determinative,

not the defendant's subjective state of mind. Wally's conduct constituted unfair competition and an unfair trade practice, and it is most inequitable to permit Wally to profit from his brother's many years of effort in promoting the name of "Findlay" on 57th Street. Wally should use any name other than "Findlay" in the operation of his business next door to his brother.

In framing its injunction the trial court went no farther than was necessary to avoid the harm threatened. It prevented the use of the name Findlay but limited this to the particular area in which its use would cause confusion and diversion—East 57th Street. It resolved the conflict with as little injury as possible to Wally. The proof showed and the trial court found that many, if not most of the leading art galleries, are now located on Madison Avenue and in the area of the 60's, 70's and 80's in New York City. Wally could probably have found an appropriate place for his New York gallery other than at 17 East 57th Street and can now either find such another location or remain where he is under some name such as "W. C. F. Galleries".

The decision in this case is in accord with the directions of our court: "The defendant has the right to use his name. The plaintiff has the right to have the defendant use it in such a way as will not injure his business or mislead the public. Where there is such a conflict of rights, it is the duty of the court so to regulate the use of his name by the defendant that, due protection to the plaintiff being afforded, there will be as little injury to him as possible." (*World's Dispensary Med. Assn.* v. *Pierce, supra,* p. 425.)

The order of the Appellate Division should be affirmed, with costs.

BURKE, J. (dissenting). This court decided in *Meneely* v. *Meneely* (62 N. Y. 427, 431-432) more than 90 years ago—and the rule, well settled then, has been consistently followed ever since—that "every man has the absolute right to use his own name in his own business, even though he may thereby interfere with or injure the business of another person bearing the same name, provided he does not resort to any artifice or contrivance for the purpose of producing the impression that the establishments are identical, or do anything calculated to mislead. Where the only confusion created is that which results from the similarity of the names the courts will not interfere. A person cannot make a trade mark of his own name, and thus obtain a monopoly of it which will debar all other persons of the same name from using their own names in their own business." (See, also, *Croft* v. *Day*, 7 Beav. 84; 49 Eng. Rep. 994 [Ch., 1843]; *Burgess* v. *Burgess*, 3 DeG., M. & G. 896; 17 Eng. L & E. 257; 22 L. J. Ch. 675 [1853]; *Turton* v. *Turton*, 42 Ch. D. 128, 140 [1889]; *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict*, 198 U. S. 118, 135-136; *Ryan & Son* v. *Lancaster Homes*, 15 N Y 2d 812; *Higgins Co.* v. *Higgins Soap Co.*, 144 N. Y. 462, 466-468; *Romeike, Inc.* v. *Romeike & Co.*, 179 App. Div. 712, 719-720; *Hilton* v. *Hilton*, 89 N. J. Eq. 182, 183-184.)

In the case before us, there is not the slightest support for any claim of dishonesty or deceit, not the slightest suggestion of a design on the part of the defendant to defraud or mislead the public or to palm off his business as that of his brother.[1] And this was the view of

[1] In fact, the defendant has been in the art business, and exceptionally well know, for some 30 years and he has used the name "Findlay" or "Findlay Galleries" in the conduct of his business throughout that entire period.

the Trial Judge below who granted the injunction solely on the strength of the possible confusion which would result from the defendant's use of his own name. Thus, declaring that he did "not believe that Wally set out to deliberately exploit this good will and business reputation of the plaintiffs", (47 Misc 2d 652) the Judge specifically ruled that it was immaterial "whether defendant *intended* to confuse and mislead, if in fact, his conduct tends or threatens to produce confusion." (47 Misc 2d 656, italics supplied.)

As the decisions cited above establish, proof of confusion—understandably inevitable when there is a similarity of name—is irrelevant since confusion resulting from the honest use of one's own name is not actionable. This is especially appropriate in a case such as this, where the patrons or customers of the plaintiff and the defendant are discriminating and knowledgeable people usually intent on acquiring a particular work of art, people ordinarily fully aware that a desired painting or other work of art can be purchased only at a particular gallery and not apt to be misled into buying by a similarity of dealers' names. Too, the evidence of confusion which, as stated, is the predicate for the injuction in this case—telephone calls to the wrong gallery, misdeliveries, visitors seeking paintings in one gallery exhibited at the other—is not unlike that presented in *Wholesale Service Supply Corp.* v. *Wholesale Bldg. Materials Corp.* (304 N. Y. 854, affg. 280 App. Div. 189, 190) and there held to be insufficient to justify the issuance of an injunction.

Moreover, there is no proof in this case of any actual damage suffered by plaintiff and in this respect it is

similar to the *Ryan* case (15 N Y 2d 912, *supra*) in which this court decided that there must be shown, if not deception or palming off, at least real and substantial confusion *plus* damage resulting therefrom. No such damage appears here although plaintiff seems mostly to fear that its reputation may in the end be somewhat diminished. The *Ryan* rationale is thus directly in point. Plaintiff seems to fear not present damage but damage in the future. It has proved no financial loss at all, shown no injury whatsoever; it has produced no customer or anyone else to testify that he was confused between the two galleries.

Despite the finding of no deceit and in the face of a claim of confusion far weaker than that proven in the cases to which we have referred, the court now refuses to apply the rule of law observed for over a century. The exception rests apparently on the singular circumstance that this competition is between siblings. We are unable to see why that should prompt the court to grant one brother the exclusive right to use the family name in connection with what was originally the family art business. We, therefore, perceive no valid basis for prohibiting the defendant from using his own name in the conduct of his business at 17 East 57th Street in New York City.

We would reverse the order appealed from and dismiss the complaint.

Chief Judge DESMOND and Judges VAN VOORHIS and BERGAN concur with Judge KEATING; Judge BURKE dissents and votes to reverse in an opinion in which Judges FULD and SCILEPPI concur.

Order affirmed.

APPENDIX B

Amended Remittitur

STATE OF NEW YORK,
IN COURT OF APPEALS

At a Court of Appeals for the State of New York, held at Court of Appeals Hall in the City of Albany on the Seventh day of July A. D. 1966.

Present, HON. CHARLES S. DESMOND, *Chief Judge, presiding.*

---

1 Mo. No. 690

DAVID B. FINDLAY, INC., & ORS.,
Respondents,
vs.

WALSTEIN C. FINDLAY, JR., & ORS.,
Appellants.

A motion to amend the remittitur in the above cause having heretofore been made upon the part of the appellants herein and papers having been submitted thereon and due deliberation having been thereupon had, it is

ORDERED, that the said motion be and the same hereby is granted, the return of the remittitur requested and, when returned, it will be amended by adding thereto the following:

Upon the appeal herein there were presented and necessarily passed upon questions under the

Constitution of the United States, as follows: Defendants-appellants contended that the Constitution of the United States guarantees the right of every man to use his own name in his own business. Defendants-appellants, also, contended that the Constitution and laws of the United States prevent a state from limiting the use of a name which is not otherwise limited by the federal patent or copyright laws, in the absence of a palming off of goods of one man as those of another. The Court of Appeals held that there was no violation of defendants-appellants' rights.

AND the Supreme Court of New York County hereby is requested to direct its Clerk to return said remittitur to this Court for amendment accordingly.

A copy

[SEAL]

GEARON KIMBALL
Deputy Clerk

Appendix C

Judgment of State Court

At a Special and Trial Term, Part XX, of the Supreme Court of the State of New York in and for the County of New York, held at the County Court House on the 23rd day of February, 1965.

Present:

HON. EMILIO NUNEZ, *Justice.*

[SAME TITLE]

The above entitled action having duly come on for trial before Mr. Justice Emilio Nunez at Special and Trial Term, Part XX, of the Supreme Court held in and for the County of New York at the County Court House, 60 Centre Street, Borough of Manhattan, on December 10 and 11, 1964, and the plaintiffs having appeared by their attorneys, Alexander & Green (J. Kenneth Campbell and Alexander Neave, of counsel), and the defendants having appeared by their attorneys, Bushwick & Barrison (Earl Barrison and Arthur M. Chait, of counsel), and the issues having been duly tried, and the Court, on January 29, 1965, having made and filed its decision in writing in favor of the plaintiffs and against the defendants for the relief demanded in the complaint herein,

Now, on motion of Alexander & Green, attorneys for the plaintiffs, it is

ORDERED, ADJUDGED AND DECREED that the defendants, their officers, agents and employees, be and they hereby

are permanently enjoined from using or employing, or causing to be used or employed, the names "Wally Findlay Galleries", "Findlay Galleries" and any other style or designation which includes the name "Findlay" in or as any part of the trade or business name under which the defendants or any of them may conduct an art gallery or art business on East 57th Street in the Borough of Manhattan, City of New York; and it is further

ORDERED, ADJUDGED AND DECREED that said defendants, their officers, agents and employees be and they hereby are permanently enjoined from displaying, distributing or circulating, or causing the display, distribution or circulation of, any advertisements or other promotional material (including, without limitation, newspaper and magazine advertisements, catalogues, announcements, listings, signs and placards) in which the names "Wally Findlay Galleries", "Findlay Galleries" or "Findlay" are employed, in whole or in part, to identify any art gallery or art business which defendants or any of them may conduct on East 57th Street in the Borough of Manhattan, City of New York; and it is further

ORDERED, ADJUDGED AND DECREED that said defendants, their officers, agents and employees, shall promptly cancel or withdraw, or cause to be cancelled or withdrawn, any such advertisements or other promotional material, which have already been placed or ordered to be published, distributed or circulated by persons other than said defendants; and it is further

ORDERED, ADJUDGED AND DECREED that upon service of a copy of this judgment upon defendants' attorneys,

with notice of entry, defendants shall forthwith comply with the terms of this Judgment except that defendants

(a) shall have five (5) days from the date of such service within which to withdraw from display or otherwise remove from defendants' premises at No. 17 East 57th Street all signs and placards incorporating the names "Wally Findlay Galleries", "Findlay Galleries" or "Findlay", and

(b) shall have fifteen (15) days from the date of such service within which to discontinue the use of all billheads, letterheads and other business stationery which employ the names "Wally Findlay Galleries", "Findlay Galleries" or "Findlay" to identify the business conducted by said defendants or any of them at said premises at No. 17 East 57th Street;

and it is further

ORDERED, ADJUDGED AND DECREED that the foregoing injunctive provisions shall apply only so long as the plaintiffs or any of them maintain an art gallery or conduct an art business at premises located on East 57th Street, in the Borough of Manhattan, City of New York, and it is further

ORDERED, ADJUDGED AND DECREED that the plaintiffs recover from defendants the sum of $182.50, as taxed as costs and disbursements herein, and have execution therefor.

Enter,

E. N.,
J. S. C.
JAMES MCGURRIN

Filed
Feb. 25, 1965
New York County Clerk's Office

LIBRARY.
SUPREME COURT, U. S.

Office-Supreme Court, U.S.
FILED
SEP 22 1966
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 479

WALSTEIN C. FINDLAY, JR., FINDLAY GALLERIES, INC., and W. C. F. GALLERIES, INC.,

Petitioners,

vs.

DAVID B. FINDLAY, INC., FINDLAY ASSOCIATES, INC., and DAVID B. FINDLAY,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

J. KENNETH CAMPBELL,
Counsel for Respondents,
120 Broadway,
New York, New York 10005.

Of Counsel:

ALFRED C. MORAN,
ALEXANDER & GREEN.

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Respondents.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

Questions Presented

As phrased by Petitioners, neither of the questions which the Petition undertakes to present was passed upon by any court below. As appears from the order of the New York Court of Appeals directing the return and amendment of the remittitur (Pet. App. B:B-2), only the following federal questions can be said to have been "presented and necessarily passed upon" below:

1. Where a particular usage of a man's own name as a trade name constitutes unfair competition under state law, should a judgment restraining that usage in a specified local area be set aside on the ground

(a) that the Constitution of the United States guarantees the right of every man to use his own name in his own business, or

(b) that the Constitution and laws of the United States prevent a State from limiting the use of a name which is not otherwise limited by the federal patent or copyright laws, in the absence of a palming off of goods of one man as those of another.

Statutes and Rules Involved

As appears more fully below, the sections of the Lanham Act quoted at pages 3 and 4 of the Petition are not involved in this case.

Rule 23 1(f) of the Rules of this Court provides in pertinent part:

"(f) If review of the judgment of a state court is sought, the statement of the case shall also specify the stage in the proceedings in the court of first instance and in the appellate court, at which, and the manner in which, the federal questions sought to be reviewed were raised; the method of raising them (e. g., by a pleading, by request to charge and exceptions, by assignment of error); and the way in which they were passed upon by the court; with such pertinent quotations of specific portions of the record, or summary thereof, with specific reference to the places in the record where the matter appears (e. g., ruling on exception, portion of the court's charge and exception thereto, assignment of errors) as will show that the federal question was timely and properly raised so as to give this court jurisdiction to review the judgment on writ of certiorari."

Statement

Plaintiff, David B. Findlay, individually or through corporations, has operated an art gallery on East 57th Street in the Borough of Manhattan, City of New York since 1936. During all of these years the gallery has been operated under the trade name "Findlay Galleries" (R. 22, 27, 29-

30). As the trial Court found (R. 135) and the New York Court of Appeals noted (Pet. App. A:A-4):

> "Through hard work, business ability and expenditure of large sums of money, David has reached the level where a significant portion of his business comes from people who have been referred to him by others and told to go to 'Findlay's on 57th Street' ".

Back in 1938 the business was owned by a now dissolved Missouri corporation, nearly all of whose stock was owned by David (R. 23-24). At that time the business had a Chicago branch which was managed by David's brother, Walstein C. Findlay, Jr. ("Wally"). In 1938 the Chicago branch was sold to Wally and he was granted the right to use the name "Findlay Galleries, Inc." in the conduct of his own business in Chicago (Pl. Ex. 1; R. 25; Pet. App. A:A-2).* Thereafter David continued the New York business on 57th Street under the name "Findlay Galleries" and has since operated no other gallery in any other location (R. 26-29, 133-134).

In 1963 Wally determined to open his own gallery in New York City. He acquired premises immediately adjacent to those of David and announced to David that he planned to open a New York gallery on those premises using the name "Findlay" (R. 37-38, 110-111). David protested (R. 37-39) and informed his brother in writing that "any funds spent by you to establish a gallery at 17 East 57th Street under the name Findlay Galleries, Inc. (or any variation thereof using the name Findlay) are spent at your peril" (Pet. App. A:A-3; Pl. Ex. 7; R. 41). Nonetheless, in the fall of 1964, Wally opened a gallery, next door to David, at No. 17 East 57th Street under the name "Wally Findlay Galleries", proclaiming it to be affiliated with "Findlay Galleries, Inc." (Pet. App. A:A-3; R. 44; Answer to Complaint, par. 5; R. 8).

---

* Petitioners' Statement fails to note that the granting of the right to use the name was limited to its use in Chicago. A question about the breadth of the grant was at issue in the trial Court. The trial Court held that "Wally's right to use the name 'Findlay Galleries, Inc.' was limited to Cook County, Illinois" (R. 137; 47 Misc. 2d 653). This issue was not contested in the New York Court of Appeals and the Court noted the limitation on Wally's right to use the name (Pet. App. A:A-2).

Both David and Wally had for years repeatedly held themselves out as "specialists" in French Impressionist and Post-Impressionist paintings (Pet. App. A:A-5; Pl. Ex. 3; R. 32; Pl. Ex. 8-D, R. 42; Pl. Exs. 9, 10, 11; R. 47; Pl. Ex. 14; R. 49; Def. Ex. A; R. 61; R. 35, 100) and had repeatedly offered for sale works of the very same artists (Pet. App. A:A-5; Pl. Ex. 3; R. 32; Pl. Exs. 3-4; R. 32; Pl. Ex. 20, R. 54; Def. Ex. A; R. 61; Def. Ex. G; R. 108).

Wally conceded on the witness stand that he knew before he opened his New York gallery that confusion between the two galleries would result (R. 123). He was surely correct; David's customers began to congratulate him on the opening of "his" new gallery next door; within a month after the opening of Wally's gallery David had received two hundred telephone calls from people seeking to reach his competitor's place of business; numerous people came into David's gallery to inquire about art works displayed at Wally's gallery and David's gallery began to experience misdeliveries of articles intended for Wally (R. 58, 83, 86, 90-93). Wally, too, began to experience some confusion at his galley (R. 123). Advertisements for Wally's gallery began to appear in New York City newspapers on the same page as advertisements for David's gallery so that the public was presented with nearly adjacent advertisements for "Findlay Galleries" at 11-15 East 57th Street and "Wally Findlay Galleries" at 17 East 57th Street (Pl. Exs. 10 and 11, R. 47).

In seven separate instances press reports on events at Wally's gallery, published in three separate New York newspapers, identified the gallery as "Findlay Galleries", the name under which David had operated for so many years (Pet. App. A:A-4; Pl. Exs. 12 through 18, inclusive, R. 48-53). Thus even press reporters, whose job it is to observe and report with accuracy, failed to make any distinction between the two galleries.

The trial Court found that Wally's conduct constituted unfair competition. The Court said that while Wally may not have set out "to deliberately exploit" his brother's

good will and business reputation, that result would follow from Wally's conduct because confusion "must necessarily result" (R. 135, 47 Misc. 2d, 652). In this connection the New York Court of Appeals held

> "The bona fides of Wally's intentions do not change the applicable principles. The objective facts of this unfair competition and injury to plaintiff's business are determinative, not the defendant's subjective state of mind. Wally's conduct constituted unfair competition and an unfair trade practice, and it is most inequitable to permit Wally to profit from his brother's many years of effort in promoting the name of 'Findlay' on 57th Street." (Pet. App. A:A-7-8).

The trial Court entered a narrow, limited injunction restraining the defendants from using the name "Findlay" as part of a trade name for the conduct of an art gallery "on East 57th Street in the Borough of Manhattan, City of New York", such injunction to "apply only so long as the plaintiffs or any of them maintain an art gallery * * * located on East 57th Street * * *" (Pet. App. C:C-2-3).

The trial Court explicitly found that "many, if not most of the leading art galleries" in New York City were located "in the area of the 60's, 70's and 80's" and not on East 57th Street (R. 136; 47 Misc. 2d, 653).

The judgment below thus left the defendants free to use the Findlay name anywhere in the world and for any purpose in the world except for the purpose of conducting an art gallery in the limited geographical area of East 57th Street. The judgment granted plaintiff's no "monopoly" of the Findlay name in any proper sense of that term. Moreover, it imposed no limitation on the use of the name as a trademark to identify goods, if any, moving across state lines.

Petitioners' Statement (at p. 4-5) contains a number of references to sales of paintings "in interstate commerce"

and the use of a family name "in nationwide sales". As more fully discussed below, the issue whether either the plaintiffs or defendants were engaged in interstate commerce was neither framed, tried or decided at any stage of the proceedings in any court below and there are no findings of fact or conclusions of law which relate to that issue.

There is no evidence that goods of any description moved or move across state lines while bearing the name "Findlay Galleries" or any variation thereof; nor is there any evidence that any of the parties made sales from their respective New York galleries for delivery outside that State. While the record does show, quite incidentally, that David placed advertisements in art magazines distributed outside New York and shows that at a prior point in time Wally traveled to certain cities in the United States to conduct art exhibitions there (R. 32-33, 36, 99), such evidence was not directed to any interstate commerce issue and would not have supported any finding on that issue if one had been made below.

ARGUMENT

a. Petitioners have not presented questions passed upon by any court below.

Petitioners have wholly failed to comply with Rule 23 1(f) of the Rules of this Court (quoted above at p. 2). The Petition is barren of any reference to the stage in the proceedings at which or the manner in which the federal questions sought to be reviewed were raised. It is also barren of other data required by that Rule, including quotations or summaries of the specific portions of the record showing "that the federal question was timely and properly raised so as to give this court jurisdiction to review the judgment on writ of certiorari".

These omissions from the Petition are far more than technical because it would be impossible for the Petitioners

to demonstrate that the Questions Presented to this Court and certain of the arguments made to this court were passed upon by any court below.

The first of the Questions Presented by Petitioners relates to the use of "a family name as a trade name in interstate commerce contrary to the provisions of the Lanham Act and decisions of the federal courts". The second of the Questions Presented refers to "the right to use a family name as a trade name in interstate commerce". (Pet., p. 2)

Parts II and III of Petitioners' argument (Pet., p. 8-10) undertake to deal with the significance of interstate commerce and the Lanham Act in this case.

Neither the words "interstate commerce" nor the words "Lanham Act" have ever once appeared in any document in this case prior to the filing of the instant Petition with this Court. At no time in this case has any court previously made or been asked to make any finding or decision relative to interstate commerce or the applicability of the Lanham Act.

The issue which was framed and tried in this case was whether the defendants' use of the name "Findlay" at premises located immediately adjacent to those of the plaintiffs, within the narrow confines of East 57th Street in the Borough of Manhattan, was such as to mislead the public into entering the defendants' premises and dealing with the defendants in the mistaken belief that they were dealing with the plaintiffs. The infringement charged was so patently local in nature that there is no need to labor the point that neither the plaintiffs nor the defendants in any way claimed or asserted, heretofore, that interstate commerce was involved.

Although the words "Lanham Act" have never heretofore appeared in this case, it is the fact that, when Petitioners moved in the New York Court of Appeals for

return and amendment of the remittitur, Petitioners asked the Court to frame an amendment reading, in part, as follows:

> "Appellants also contended that the Constitution and laws of the United States prevent a state from limiting the use of a name which is not otherwise limited by the federal patent, copyright, *or trademark laws,* * * *" (Emphasis supplied)

In Appendix A to this brief we have reproduced Petitioners' Notice of Motion from which the foregoing extract is taken.

Respondents protested in their opposing papers that there had never been any prior reference to federal trademark laws in the case and that the New York Court of Appeals had therefore never considered or passed upon the question as phrased by appellants (Petitioners here).

The amended remittitur ordered by the New York Court of Appeals omitted all reference to federal trademark laws (See Pet. App. B: B-2) and that Court thus refused to agree that any question arising under federal trademark laws had been presented to it.

While that Court agreed that it had "necessarily" passed upon the federal questions recited in the amended remittitur, it is noteworthy that no reference even to those questions is to be found in either the majority or minority opinions filed in that Court.

We advert below to certain other deficiencies in Petitioners' arguments relating to interstate commerce and the Lanham Act. However, Respondents' primary position is that the Petition here should be denied for failure to comply with Rule 23 1(f) of the Rules of this Court and for failure to present questions considered and passed upon by any court below.

b. The decision below does not conflict with any "federal rule".

It is, of course, Respondents' position that the decision below dealt with a matter governed solely by state law and that it is, therefore, not relevant whether that decision is in conflict with any alleged federal rule. See *Pecheur Lozenge Co., Inc.* v. *National Candy Co., Inc.* 315 U.S. 666, 667 (1942). Actually, however, there is no conflict between the decision below and the rules pronounced by federal courts, including this Court.

The essence of the New York Court's ruling is that a man's use of his own name in trade may be enjoined if the injury to the plaintiff arises out of something more than the mere similarity of name, i.e., resort to an artifice or contrivance or the doing of acts calculated to mislead the public into believing that one's business is that of his competitor (Pet. App. A:A-6). The artifice, contrivance or act calculated to mislead in this case was found in the defendants' conduct in locating themselves at premises immediately adjacent to the plaintiffs so that confusion between the two businesses became inevitable.

There is no conflict between such a rule and the rule of *Howe Scale Co.* v. *Wyckoff, Seamans, etc.,* 198 U.S. 118 (1905) (relied on by Petitioners) which was a case where the defendants had been enjoined from the use of a personal name "in any manner whatsoever". Moreover, in commenting on that case in *Waterman Co.* v. *Modern Pen Co.,* 235 U.S. 88 (1914) (on which Petitioners also rely), this Court said (at p. 94):

> "But, whatever generality of expression there may have been in the earlier cases, it now is established that when the use of his own name upon his goods by a later competitor will and does lead the public to understand that those goods are the product of a concern already established and well known under that name, and when the profit of the confusion is known to and, if that be material, is intended by the later man, the law will

require him to take reasonable precautions to prevent the mistake."

The New York Court of Appeals referred in this case to a plaintiff's right to have a defendant use his own name in such a way as will not injure the plaintiff's business or mislead the public and it spoke of the court's duty to regulate the use of a defendant's name (Pet. App. A:A-8). In applying that rule to this case the Court said: (*id.*)

> "In framing its injunction the trial court went no farther than was necessary to avoid the harm threatened. It prevented the use of the name Findlay but limited this to the particular area in which its use would cause confusion and diversion—East 57th Street. It resolved the conflict with as little injury as possible to Wally."

c. Federal law has not ousted States of jurisdiction over unfair use of trade names.

Petitioners' arguments relative to the Lanham Act's creation of a federal law of unfair competition and the application of this Court's decisions in *Compco* and *Stiffel* to that area are without merit.

None of the Circuit Court cases cited by Petitioner (Pet., pp. 8-9) holds that federal law has preempted the field of unfair competition so as to deprive a State of power to control such conduct within its borders. A minority view in one circuit (e. g., *Stauffer* v. *Exley*, 184 F.2d 962 (9th Cir. 1950)) appears to hold that an aggrieved plaintiff may have recourse to the federal courts and take advantage of a federal body of substantive law arising out of the Lanham Act, provided the plaintiff is able to establish that his interstate business is adversely affected by the defendant's conduct. This minority rule is irrelevant here where the plaintiffs have never endeavored to make any such showing.

It is pointed out that other circuits may be in conflict with such a view. Even if so, that would not seem to afford any basis for the exercise of this Court's discretion to grant a writ of certiorari. The decision sought to be reviewed here is a decision of a state court; not the decision of a Federal Court of Appeals which is in conflict with a decision of another Federal Court of Appeals. Cf. Rule 19 of this Court's Rules.

Petitioners next point out that the Lanham Act denies the right of registration to a trademark that is essentially a surname. This observation is meaningless in a case which does not involve trademarks or the use of any identifying mark, as such. So far as we know, no one has ever suggested that federal law prohibits invocation of the rules of unfair competition to afford protection to a trade name which is a surname. Indeed, *Stauffer* v. *Exley, supra,* involved the possible right to federal protection of the surname "Stauffer" as a trade name.

Petitioners argument finally proceeds to the claim that the decision below is inconsistent with the decisions of this Court in *Compco Corp.* v. *Day-Brite Lighting Inc.*, 376 U.S. 234 (1964) and *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U.S. 225 (1964).

These cases dealt with the lack of power in the States to employ the principles of unfair competition to effect a broader grant of rights than is effected by federal patent and copyright laws. In *Stiffel* this Court pointed out that Article 1, § 8, cl. 8 of the Federal Constitution affirmatively placed control of the patent and copyright fields under the Federal Government "because, as Madison put it in *The Federalist* No. 43, the States 'cannot separately make effectual provision' for either patents or copyrights. • • •" (376 U.S. at 228).

These cases have established no similar rule with respect to a State's power to protect the public and the businessman from unfair or tortious appropriation of a trade name. Indeed, in *Stiffel* this Court explicitly acknowledged the

power of the States to "protect businesses in the use of their trademarks, labels or distinctive dress in the packaging of goods so as to prevent others, by imitating such markings from misleading purchasers as to the source of the goods" (376 U.S. at 232).

d. Defendants have not been deprived of liberty or property without due process.

Conceding *arguendo* that a man's name may be regarded as property, there is nothing in the judgment below which deprives the defendants of such property. The most that can be said is that the injunction has imposed a relatively minor qualification, limitation or regulation of the defendants' rights in that the defendants have been enjoined from using the name "Findlay" only in the conduct of a particular kind of business, in a very small and limited geographic area and only so long as the plaintiffs maintain a competing business in that same area.

The Constitutional guarantees of rights to use and enjoy property have never been understood to go so far as to permit such use to the injury of the legal rights of others (*Crowley* v. *Christensen,* 137 U.S. 86, 90 (1890); *Nebbia* v. *New York,* 291 U.S. 502, 538, 539 (1934)).

Indeed, in *Hilton* v. *Hilton,* 89 N.J. Eq. 182, 104 Atl. 375 (1918), cited in support of Petitioners' argument, the New Jersey Court approved a formula under which the defendant was enjoined from using his own name so as to induce the public to believe that "the business conducted by defendant is the same as or a part of the business conducted by complainant" (89 N.J. Eq. at p. 183). See also *Garrett* v. *Garrett & Co.,* 78 Fed. 472, 478 (C.C.A. 6th 1896).

Griswold v. *Connecticut,* 381 U.S. 479 (1965) involving the right to practice birth control, is wholly inapplicable here.

CONCLUSION

For the reasons set forth above, it is respectfully submitted that the petition for a writ of certiorari should be denied.

Dated: September 22, 1966.

Respectfully submitted,

J. KENNETH CAMPBELL,
Counsel for Respondents.

Of Counsel:

ALFRED C. MORAN
ALEXANDER & GREEN

APPENDIX A

Motion to Amend Remittitur

COURT OF APPEALS
OF THE STATE OF NEW YORK

DAVID B. FINDLAY, INC., FINDLAY ASSOCIATES, INC. and DAVID B. FINDLAY, *Plaintiffs-Respondents* *—against—* WALSTEIN C. FINDLAY, JR., FINDLAY GALLERIES, INC. and W. C. F. GALLERIES, INC., *Defendants-Appellants.*	Motion for Return and Amendment of Remittitur

Sirs:

Please take notice that, upon the annexed statement of Milton Pollack, subscribed and affirmed June 29, 1966, the remittitur of this Court herein dated June 9, 1966, the record on appeal to this Court, and upon all the pleadings and proceedings heretofore had herein, the undersigned will move this Court, on the next motion day thereof, at Court of Appeals Hall, Eagle Street, Albany, New York, for an order requesting the return of said remittitur to add thereto the following federal questions:

> "Upon the appeal herein there were presented and necessarily passed upon questions under the Constitution and laws of the United States, viz.: Appellants contended that the Constitution of the United States protects the right of every person to use his own name in the conduct of his business, and that the state may not limit such right because of a possibility of confusion, in the absence of deceit or palming off (which are not

present and were not contended here to exist). Appellants also contended that the Constitution and laws of the United States prevent a state from limiting the use of a name which is not otherwise limited by the federal patent, copyright, or trademark laws, in the absence of deceit or palming off (which are not present and were not contended here to exist), and in the absence of proof of actual confusion (which was not present or shown here to exist). The Court of Appeals denied such contentions.

and for such other and further relief as to the Court may seem just and proper.

Dated: New York, N. Y.
June 29, 1966

Yours, etc.,

MILTON POLLACK
Attorney for Defendants-Appellants
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111 Broadway
New York, N. Y. 10006
WO 4-5770

To:

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RE 2-4290

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1966

No. 479

WALSTEIN C. FINDLAY, JR., FINDLAY GALLERIES, INC., and W. C. F. GALLERIES, INC.,
Petitioners,

v.

DAVID B. FINDLAY, INC., FINDLAY ASSOCIATES, INC., and DAVID B. FINDLAY,
Respondents.

REPLY BRIEF IN SUPPORT OF PETITION FOR A WRIT OF CERTIORARI

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Respondents' answering brief is in error when it asserts (p. 8) that no reference to the federal questions is to be found in either the majority or minority opinions of the Court of Appeals.

1. The dissenting opinion of Judge Burke relied on the New York rule laid down "in *Meneely* v. *Meneely* (62 N. Y. 427, 431-432) more than 90 years ago—and * * * consistently followed ever since * * *." (A-9) This rule as repeated by Judge Burke, with whom the other two dissenters concurred, was:

> "A person cannot make a trade mark of his own name, and thus obtain a monopoly of it which will

debar all other persons of the same name from using their own names in their own business."

The majority of the Court of Appeals, by declining to follow the *Meneely* case, and its rule as reiterated by the dissenting opinion in the Court of Appeals, has held that a person *can* make a trade mark of his own name. The conflict with federal law is clear.

It is also clear that the decision of the Court of Appeals, which deprives Wally Findlay of the right to use his own name, without any proof of any fault or wrongdoing by him, deprives him of both liberty and property rights of value, in violation of the Fifth, Ninth, and Fourteenth Amendments to the Constitution of the United States.

The property right of a person in his own name, and that "he has the same right to its use and enjoyment as he has to that of any other species of property" were recognized in the very case the majority of the Court of Appeals purported to follow, *World's Dispensary Medical Ass'n* v. *Pierce*, 203 N. Y. 419, 424 (1911) (A-7, A-8), and in the decisions cited in the dissenting opinion (A-9). The New York law, as a result of the majority opinion of the Court of Appeals, now allows confiscation of at least part of a person's property right in his name without any showing of fault on his part and without any requirement of compensation. Such a rule patently conflicts with the United States Constitution.

2. Respondents in this Court concede the existence of a conflict among the Federal Courts of Appeals by labeling the position of the Ninth Circuit a "minority rule" (Br. p. 10). It is the fact of conflict, not the size of the majority, that justifies this Court's review.

3. Respondents cavil by denying the existence of interstate commerce (Br. p. 6). Petitioner Wally Findlay is obviously engaged in interstate commerce, since he has galleries in Chicago and Palm Beach (A-2) as well as New York, and the injunction below bars his use of his name, in connection with his New York gallery, in "newspaper and magazine advertisements" (C-2). It should also be obvious, even to those not connoisseurs of the arts, that foreign commerce is involved, since the source of French impressionist and post-impressionist paintings, in which both petitioners and respondents specialize (A-5), is France.

4. *Hilton* v. *Hilton*, 89 N. J. Eq. 182, 104 Atl. 375 (1918), remains a controlling authority, in spite of respondents' attempt to distinguish it (Br. p. 12). There is no showing here that Wally Findlay used his name so as to induce the public to believe that his business was the same as or a part of the business conducted by his brother. Furthermore, the Courts below did not attempt to regulate Wally Findlay's use of his name—they flatly barred it, even in the form "Wally Findlay" (C-2).

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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